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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,982	01/21/2004	Michel Tabart	ST01021US CNT	4039

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EXAMINER

STOCKTON, LAURA

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/761,982

Applicant(s)

TABART ET AL.

Examiner

Laura L. Stockton, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 23-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/19/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

Claims 1-35 are pending in the application.

***Election/Restriction***

Applicants' election with traverse of Group IV (claims 1-22 and 35) in the reply filed on December 17, 2004 and the species of Example 2-1 (page 19) in the reply filed on January 18, 2005 is acknowledged. The traversal is on the ground(s) that the twelve way restriction is improper because: (1) no serious burden would be placed on the Examiner or the Office's resources to search all of the claims as they are in the same and/or similar classification; (2) there was no lack of unity imposed on the corresponding PCT Application No. PCT/FR02/02638; (3) the process of using claims should be rejoined if the product claims are found allowable; and (4) the restriction imposes undue expenses on Applicants.

All of Applicants' arguments have been considered but have not been found persuasive. Separate search considerations, not only class and subclass searches, are involved for each of the groups outlined in the Restriction Requirement dated November 18, 2004.

Having various groups classified in the same class does not reduce the burden on the Examiner when a multitude of subclasses within a class would have to be searched. Therefore, it would impose an undue burden on the Examiner and the Patent Office's resources if unrestricted.

In regard to the argument concerning the absence of a lack of unity being made in the International phase, the national Examiner is not bound by the decisions made by the Examiner in the International phase. The instant application is a CON of PCT/FR02/02638 and not a 371. Therefore, restriction practice under 35 USC §121 is applicable. See MPEP 1895.01, section D. Section 121 provides the Director of Patents and

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Trademarks with the authority to restrict applications to several claimed inventions when those inventions are found to be independent and distinct. In the instant application, the Examiner has determined that several independent and distinct inventions are claimed in the application.

Further, in accordance with M.P.E.P. §821.04 and In re Ochiai, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims with process claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. Until, such time, a restriction between product claims and process claims is deemed proper.

Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution to maintain either dependency on the product claims or to otherwise include the limitations of the product claims. **Failure**

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to do so may result in a loss of the right to  
rejoinder.

The requirement is still deemed proper and is  
therefore made FINAL.

Subject matter not embraced by elected Group IV and  
Claims 23-34 are withdrawn from further consideration  
pursuant to 37 CFR 1.142(b), as being drawn to  
nonelected inventions. Applicant timely traversed the  
restriction (election) requirement in the replies filed  
on December 17, 2004 and January 18, 2005.

***Priority***

Receipt is acknowledged of papers submitted under  
35 U.S.C. 119(a)-(d), which papers have been placed of  
record in the file.

***Information Disclosure Statement***

The Information Disclosure Statement filed February 19, 2004 has been considered by the Examiner.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-22 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, under the definition of 5 or 6 membered aromatic heterocyclic in Ar, an "and" is needed after "NH(C<sub>1</sub>-C<sub>4</sub>)alkyl" (page 166, line 19) to conform to proper Markush language.

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Claim 5 lacks antecedent basis because of the definition of  $Ra_1$ .

Claim 14 does not conform to M.P.E.P. 608.01(m) since each claim must end with a period.

Claim 15 lacks antecedent basis for the broad definition of Ar.

Claim 18 lacks antecedent basis from claim 14.

***Allowable Subject Matter***

The elected species of Example 2-1 on page 19 is allowable over the art of record.

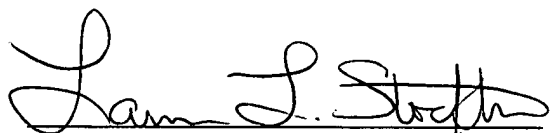
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

A handwritten signature in black ink, appearing to read "Laura L. Stockton", is written over a horizontal line.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

April 4, 2005